Supreme Court, U.S.
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No. 97-1918

In The

Supreme Court of the United States

October Term, 1997

HOWARD A. FROMSON,

Petitioner,

vs.

ANITEC PRINTING PLATES, INC., JAMES R. SULLIVAN and THOMAS P. RORKE,

Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF IN OPPOSITION FOR RESPONDENT ANITEC PRINTING PLATES, INC.

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RULE 29.6 STATEMENT

Pursuant to Rule 29.6 of the Rules of this Court, Respondent Anitec Printing Plates, Inc. states as follows:

During the proceedings below and until April 30 1998, Respondent Anitec Printing Plates, Inc. was a subsidiary of International Paper Company.

As of April 30, 1998 Respondent Anitec Printing Plates, Inc. was acquired by Kodak Polychrome Graphics LLC. Kodak Polychrome Graphics LLC is a joint venture owned by the Eastman Kodak Company and Sun Chemical Corporation.

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Respondent Anitec Printing Plates, Inc. ("Anitec") respectfully requests that this Court deny the Petition for a Writ of Certiorari filed by Petitioner Howard A. Fromson ("Fromson"), seeking review of the opinion of the United States Court of Appeals for the Federal Circuit in this case, affirming in relevant part the decision of the United States District Court for the District of Massachusetts ruling that Anitec's process for continuously anodizing aluminum did not infringe Fromson's United States Patent No. Re. 29,754.

SUMMARY OF ARGUMENT

The question presented by Fromson has already been addressed and answered by this Court in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996) ("*Markman II*"). In construing the terms of the Fromson patent claims the United States Court of Appeals for the Federal Circuit correctly stated and properly applied the law as set out in *Markman II* regarding the use of extrinsic evidence. Fromson here seeks only to have this Court draw a different conclusion on the same facts and the same controlling law that was before the court below. Grant of a writ on these facts and circumstances is not warranted.

STATEMENT OF THE CASE

Fromson's patent is directed to a continuous anodization process wherein a continuous aluminum web passes through a first anodizing cell, a "contact" cell, and then a second anodizing cell. Anodizing current for both anodizing cells is introduced by way of the contact cell using separate power supplies. This arrangement results in a protective coating being formed on the aluminum before it reaches the contact cell. In the language of the claims, the aluminum has "an anodized oxide coating formed thereon" (claim 2); or a "portion of the anodizing" carried out (claim 11); or "a portion of the thickness of said porous anodic

oxide coating already formed thereon" (claim 14). *See* Pet. App. at 132a-134a.[1] For ease of reference, these terms are collectively referred to as "anodizing."[2]

The parties' dispute on patent infringement centered on the proper construction of the patent claims. Construction of the claims, in turn, focussed on the meaning of the patent term "anodizing". Anitec contended that the word meant that a protective coating was applied to the aluminum web in the first anodizing cell to protect the web from the burning and current surging that Fromson's patent asserted it would otherwise be subjected to in the subsequent contact cell. Fromson, on the other hand, argued, and continues to argue, that the term should be given what he contends is its "ordinary" definition, e.g., subjecting a metal to electrolytic action by making it the anode of a cell before coating it with a protective or decorative film.[3] *See* Pet. at 4-5; *Fromson v. Anitec Printing Plates, Inc.*, 132 F.3d 1437, 1444 (Fed. Cir. 1997) ("*Fromson II*"), Pet. App. at 11a.

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1. References to "Pet. App. at __" refer to citations to the Petition Appendix. References to "Pet. at __" refer to citations to the Petition.

2. A more detailed discussion of the patented invention is found in the Federal Circuit's opinion at *Fromson v. Anitec Printing Plates, Inc.*, 132 F.3d 1437, 1439-41 (Fed. Cir. 1997) ("*Fromson II*"), Pet. App. at 3a-6a, which is incorporated by reference herein.

3. Fromson contradicts his own proposed definition for "anodizing". He asserts that his patent includes a definition which is "essentially the same" as the dictionary definition. *See* Pet. at 4. According to Fromson, the patent defines anodizing as "electrolytically forming an oxide coating by subjecting an aluminum web to the action of direct current by making the web the anode of a cell." Pet. at 5. However, the patent definition is narrower than Fromson's "ordinary" meaning in requiring the formation of an oxide coating. Fromson overlooks the fact that the cited portion of his patent requires that the oxide formed should be a "protective oxide layer". *See* Pet. App. at 125a. This protective oxide layer is said to afford protection against the current arcing and surging problem which the patented process claims to solve. *See* Pet. App. at 123a.

Both the District Court and the Court of Appeals concluded, as a matter of law, the former construction to be the correct one. The district court held that the term "anodizing" as used in Fromson's patent claims, means an electrolytically formed adherent, porous aluminum oxide coating sufficiently thick to protect against the burning and arcing problems addressed by the patent. *See Fromson v. Anitec Printing Plates, Inc.*, 39 USPQ2d 1727, 1733 (D. Mass. 1996) ("*Fromson I*"), Pet. App. at 40a-41a. Both lower courts properly construed the disputed patent claim term "anodizing" in light of the claims, specification, file history and prior art, and concluded, as matter of law, that anodizing requires protection of the aluminum web from burning and current surging. The claim construction was confirmed by appropriate reference to extrinsic evidence to show what "anodizing" meant to one skilled in the art at the time the patented invention was made (1973). The district court found that Anitec's accused process did not read on the claims as construed under *Markman II*.

The court of appeals affirmed the construction of the claims as correct as a matter of law, and affirmed the finding of non-infringement under that construction as not clearly erroneous. *See Fromson II*, 132 F.3d at 1445, Pet. App. at 15a.

A. The District Court Decision

The District Court's claim interpretation was premised on a direct application of the *Markman I*[4] formula:

> In determining the meaning of the patent claim, the court should consider three principal sources: the claims themselves, as set forth in the patent; the specifications [sic] [and] the prosecution history. I

4. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996) ("*Markman I*").

> am also entitled as a matter of my discretion to consider secondary sources such as expert testimony and other extrinsic evidence.

Fromson I, 39 USPQ2d at 1733, Pet. App. at 40a. The district court determined that Anitec's proposed claim interpretation should be adopted because: (1) "it is the meaning that is most consistent with the claims themselves [which] refer either to an electrolytic process or to the formation of a porous oxide"; and (2) it "is most consistent with the specifications [sic] . . . which referred to a porous oxide and which referred to thicknesses sufficient to prevent burning." *Id.* Pet. App. at 41a. Indeed, the court emphatically noted that "I have a hard time imagining anyone reading the specifications [sic] *along with the claims concluding that anything else could have been intended by this patent*." *Id.* (emphasis added). The court added that, in addition, the prosecution history is "most consistent with the defendant's view of the appropriate construction of the term anodizing." *Id.*

On the issue of claim construction, the court cited the extrinsic evidence twice, first finding "that anodization in 1973 did have a fairly clear meaning in terms of its industrial application, and that meaning is consistent with [defendant's proposed] definition." *Id.*, Pet. App. at 40a. Second, the district court concluded that

> [f]inally, the extrinsic and expert testimony is, I would describe, overwhelming in support of the defendant's position that an oxide coating in excess of 1,000 nanometers would have been considered in 1873 [sic — 1973] a minimum for what any person reasonably skilled in the art would have called anodization.

Id., Pet. App. at 42a.[5]

5. While the district court's decision was handed down before the Federal Circuit's decision in *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576 (Fed. (Cont'd)

After construing the claims, the district court addressed the second part of the literal infringement test: "when I compare the claims as I have construed them, to the process at issue in this litigation, it is obvious that the process does not infringe the Fromson patent." *Id.* at 1734, Pet. App. at 42a. The court then reviewed the extensive evidence presented at trial regarding the coating present on the aluminum emerging from the phosphoric acid tank of the accused Anitec process and concluded that:

> the Anitec process has not been shown convincingly to produce any oxide coating in the phosphoric acid tank. Or if it does produce an oxide coating, it has not been shown to produce this oxide coating as a result of any electrolytic process, which is an essential requirement of the plaintiff's patent.

Id., Pet. App. At 43a.

(Cont'd)
Cir. 1996), it was entirely consistent with the requirements of *Markman*. Nonetheless, even if all of the extrinsic evidence relied upon by the district court (and the Federal Circuit) were ignored, the result would be the same — "anodizing," based on consideration of the intrinsic evidence alone, means providing a coating which protects the web from burning and current surging. *See Fromson I*, 39 USPQ2d at 1733, Pet. App. 40a-41a.

The district court also considered that "defendants frequently used the word 'anodization' to refer to what happened in the phosphoric tank", but recognized that this was simply loose usage of a term by employees in connection with the manufacturing process because the aluminum web was rendered anodic in that tank, "not because there was anything that could be called anodizing as that word is used as a term of art." *Fromson I*, 39 USPQ2d at 1734, Pet. App. at 44a. The Federal Circuit did not find the district court to be clearly erroneous on this point.

B. The Federal Circuit Decision

In reviewing the district court's holding of non-infringement, the Federal Circuit performed its own *de novo Markman* analysis, and set about to determine the meaning of "anodizing". The court first considered the patent specification and found that it:

> requires that an anodized oxide coating be formed on the aluminum web before it enters into the contact cell, and teaches that the purpose of this preliminary coating is to protect the web from burning and current surging in the contact cell.

Fromson II, 132 F.3d at 1443, Pet. App. at 9a. The court also considered the file history of the '754 reissue patent and the prior art and concluded that:

> the reissue prosecution does not of itself limit all of Fromson's claims to porous oxide, but that Papst's [the reference prompting the reissue prosecution] (and Fromson's) recognition that barrier oxide can be formed, along with other evidence, supports the district court's ruling.

Id., Pet. App. at 11a.

As to the extrinsic evidence, the Federal Circuit held that the technical experts not only aided the court's understanding of the technology, they also provided evidence material to the interpretation of the claims. Based on expert testimony, the court concluded that since not all electrolytically-formed oxide coatings will protect the web as it moves into the contact cell — a fundamental purpose of the Fromson process — the "anodized" coating formed on the aluminum before entry into the contact cell must be such a protective oxide. Thus, the extrinsic evidence

confirmed the meaning of the claim term "anodizing" as construed in light of the intrinsic evidence.

REASONS FOR DENYING THE WRIT

I.

THE COURT OF APPEALS FOR THE FEDERAL CIRCUIT, AND THE DISTRICT COURT BEFORE IT, CORRECTLY STATED, AND PROPERLY APPLIED, THE LAW GOVERNING THE USE OF EXTRINSIC EVIDENCE IN CONSTRUING THE MEANING OF PATENT CLAIMS[6]

In its decision below, the Federal Circuit, the appellate tribunal vested with exclusive appellate jurisdiction over matters arising under the patent laws, 28 U.S.C. § 1295(a)(1), expressed a clear understanding of the role of the judiciary in construing the meaning of the terms used in patent claims:

> The claims define the patent grant and set its boundaries; that is, they establish the patentee's legal rights. When technical or scientific terms in the claims require definition or explanation or understanding in the course of deciding whether the claims are infringed, it is the judicial duty to do so. *Markman v. Westview Instruments, Inc.*, [517 U.S. 370, (1996)]. In performing this construction, certain of the technologic facts were undisputed and others were strongly disputed insofar as technologic conclusions

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6. This section addresses Points I, III, IV and V of Fromson's Reasons for Granting the Writ. While Fromson presents seven individual Reasons for Granting the Writ, many of them are interrelated. Where appropriate, Anitec has attempted to respond to Fromson's "Reasons" as a group.

> based thereon were material to the issue of the meaning and scope of the claims.

Fromson v. Anitec Printing Plates, Inc., 132 F.3d 1437, 1441-42 (Fed. Cir. 1997), *reh'g denied*, 1998 U.S. App LEXIS 4149 (1998) ("*Fromson II*"), Pet. App. at 7a.

As part of its *de novo* review of the patent claims, the Federal Circuit first determined that the parties disputed the meaning of the terms "anodizing" and "anodized"[7]. The court then went on to correctly explain the role of extrinsic evidence in claim construction:

> The analysis of infringement is a two-step progression. In the first step the Court construes the claims of the patent; that is, the Court explains and defines any disputed technical terms and sets the scope and boundaries of the claims. In so doing the Court looks principally to the patent specification and any explanatory information in the patent examination record. The Court may gain understanding of the state of the art at the time the invention was made, from the prior art or from experts in the technologic field. Physical and experimental evidence may be helpful, as in this case.

Id. at 1442, Pet. App.at 8a.

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7. The first of seven distinct reasons proffered by Fromson for granting a Writ is that the Federal Circuit turned to extrinsic evidence prior to deciding that the "public record" was ambiguous. The fundamental premise of this argument is flawed. Prior to considering the extrinsic evidence, the Federal Circuit found the claim terms at issue to be disputed as to meaning, and that "the specific technical aspect that is potentially of dispositive weight was not discussed in the specification or explored during the patent prosecution." *Fromson II*, 132 F.3d at 1444, Pet. App. at 12a.

In reviewing the district court decision (and conducting its own *de novo* construction of the claims), the Federal Circuit first turned to, and expressly relied on, those intrinsic sources used to inform the construction of a claim — the specification (*Fromson II,* 132 F.3d at 1442, Pet. App. at 9a), the prosecution history (*Id.* at 1443, Pet. App. at 10a), and the prior art (*Id.*, Pet. App. at 10a-11a). *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582-83 (Fed. Cir. 1996).

In each instance, the Federal Circuit properly stated the law concerning the use of the intrinsic references to construe a claim, and agreed that such references supported Anitec's proffered construction. Only *after* considering these intrinsic sources did the court turn to the extrinsic sources — and found them consistent with Anitec's proffered claim construction, as well as with the claim construction made by the district court. *See Fromson II,* 132 F.3d at 1442-45, Pet. App. at 8a-14a. Thus, the Federal Circuit followed precisely the course charted by this Court in *Markman II*:

> The decisionmaker vested with the task of construing the patent [the judge] is in the better position to ascertain whether an expert's proposed definition fully comports with the specification and claims and so will preserve the patent's internal coherence.

Markman II, 570 U.S. at 390. *See also Markman I*, 52 F.3d at 981[8]; *Vitronics,* 90 F.3d at 1584 ("No doubt there will be instances

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8. Through this process of construing claims by, among other things, using certain extrinsic evidence that the court finds helpful and rejecting other evidence as unhelpful, and resolving disputes en route to pronouncing the meaning of claim language as a matter of law based on the patent documents themselves, the court is not crediting certain evidence over other evidence or making factual evidentiary findings. Rather, the court is looking to the extrinsic

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in which intrinsic evidence is insufficient to enable the court to determine the meaning of the asserted claims, and in those instances, extrinsic evidence, such as that relied on by the district court, may also properly be relied on to understand the technology and to construe the claims".); *Bell & Howell Document Management v. Altek Sys.*, 132 F.3d 701, 706 (Fed. Cir. 1997) ("Use of expert testimony to explain an invention may be useful. But reliance on extrinsic evidence to interpret claims is proper only when the claim language remains genuinely ambiguous after consideration of the intrinsic evidence. . . ."). The decision of the Federal Circuit was thus wholly consistent with the teachings of both *Markman I* and *Markman II*.

Fromson argues that in later decisions the Federal Circuit was itself unable to reconcile *Markman I* with the *Fromson II* decision upon which Fromson seeks review here. Yet, the case Fromson quotes from in support of his argument actually did just that:

> Senior Judge Archer, writing for the majority in *Cybor*, found it "*difficult* to reconcile the language and reasoning in the court's recent opinion in *[Fromson II]* with *Markman I*, although the opinion purports to do so."

Pet. at 14 (emphasis added) (quoting *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454 n.3 (Fed. Cir. 1998) (en banc)), Pet. App. at 60a n.5) Fromson's disagreement with the approach

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> evidence to assist in its construction of the written document, a task it is required to perform. The district court's claim construction, enlightened by such extrinsic evidence as may be helpful, is still based upon the patent and prosecution history.

Markman I at 981 (footnote omitted).

employed by the Federal Circuit to reconcile prior precedent does not mean the court was unable to do so. In fact, the court *expressly* reconciled *Fromson* with *Markman I*, as Senior Judge Archer concluded:

> Although the extrinsic evidence — expert testimony, prior art, and scientific tests — confirmed the District Court's claim construction, it was directed primarily to whether Anitec's thin, nonporous oxide layer infringed the claims. To this extent, the holding in *Fromson* affirming the district court's claim interpretation follows *Markman I. See Bell & Howell Document Management v. Altek Sys.*, [132 F.3d 701, 705-06 (Fed. Cir. 1997)]; *Vitronics Corp. v. Conceptronic, Inc.*, [90 F.3d 1576, 1584 (Fed. Cir. 1996)].

Cybor, 138 F.3d at 1454-55 n.3, Pet. App. at 61a n.5.

Fromson seeks nothing more than to have this Court act as a "super" court of appeals, undertaking a technically complex *de novo* review — considering the same record that was considered by the Federal Circuit, and the district court before it. Merely disagreeing with the conclusions drawn from the record below, reached after consideration and application of the appropriate law, does not warrant the grant of certiorari[9].

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9. Fromson also urges as a separate reason for granting certiorari that the Federal Circuit has "departed from its own precedent on claim differentiation". Pet. at 21. This is simply not the case. The claim differentiation doctrine states that if supportable, two claims should not be construed so as to be equal in scope. The Federal Circuit opinion in *Fromson II*, 132 F.3d at 1445, (Pet. App. at 14a), is altogether consistent with the court's precedent that:

> the doctrine of claim differentiation can not broaden claims beyond their correct scope, determined in light of the specification and the

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II.

WHILE FROMSON SEEKS CERTIORARI ON THE ISSUE OF THE STANDARD OF REVIEW APPLIED BY THE FEDERAL CIRCUIT, IT WAS NOT FAIRLY INCLUDED AS A QUESTION PRESENTED; MOREOVER, THE CORRECT STANDARD OF REVIEW WAS APPLIED BELOW[10]

Fromson presents a single question for consideration by this Court — the role of extrinsic evidence in construing the meaning of the terms in a patent claim. Notwithstanding, Fromson advances as an independent reason for granting a Writ that the Federal Circuit decided *Fromson II* under the clearly erroneous standard of review which was subsequently disavowed by the court sitting en banc in *Cybor*. Because this issue is not presented in Fromson's Questions Presented, and is not fairly included within the Question Presented, it should not be considered as a reason for granting a writ.[11] Supreme Court Rules 14.1(a) ("Only the questions set out in the petition, or fairly included therein, will be considered by the Court."). *See also Yee v. City of Escondido*, 503 U.S. 519,

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(Cont'd)

> prosecution history and any relevant extrinsic evidence. As explained in [*Tandon Corp. v. U.S. Int'l Trade Comm'n*, 831 F.2d 1017, 1023 (Fed. Cir. 1987)] claims that are written in different words may ultimately cover substantially the same subject matter. *See also Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1269, (Fed. Cir. 1986) (affirming district court's construction of a claim although it rendered a dependent claim redundant).

Multiform Desiccants, Inc. v. Medzam, Ltd., 133 F.3d 1473, 1480 (Fed Cir. 1998).

10. This section addresses Points II and VI of Fromson's Reasons for Granting the Writ.

11. Furthermore, the question was not presented by Fromson in his petition for rehearing of the Federal Circuit's decision.

535 (1992) ("we ordinarily do not consider questions outside those presented in the petition for certiorari.").[12]

The standard of review applied by the Federal Circuit to the question presented, especially as phrased by Fromson, is independent of the substantive issues underlying the question presented. The gravamen of the question presented by Fromson is that the Federal Circuit improperly turned to extrinsic evidence to determine the meaning of the words of the claims of the patent in suit. This is distinct from the standard of review (*de novo*) that the Federal Circuit applied in its review of the claim construction reached, in the first instance, by the District Court. This issue is not subsumed in the question presented here by Fromson.

Moreover, the Federal Circuit opinion made clear that the correct standard of review was applied. A determination of infringement is a two step process.

> First, the court determines the scope and meaning of the patent claims asserted, *see Markman II*, [517 U.S. at 371-73], and then the properly construed claims are compared to the allegedly infringing device.

Cybor, 138 F.3d at 1454. The first issue, claim construction, is reviewed *de novo* on appeal. *See id.* "The application of the claim to the accused device is a question of fact, reviewed for clear error." *General American Trans. Corp. v. Cryo-Trans, Inc.*, 93 F.3d 766, 769 (Fed. Cir. 1996).

This is exactly the two-tiered standard applied in Judge Newman's opinion. As to the construction of the claim, the court stated: *"We affirm the construction of the claims as correct."*

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12. In *Yee*, this Court even rejected "related" and "complementary" questions as not being "fairly included" within the specific question presented. *See Yee*, 503 U.S. at 537.

Fromson II, 132 F.3d at 1445, Pet. App at 15a (emphasis added). On the other hand, when considering the district court's application of the construed claim to the accused process, the court stated: *"We do not discern clear error in the court's application of the claims, as construed, to the accused process." Id.* (emphasis added).

Thus, consistent with the *en banc* holdings of *Cybor*, the Federal Circuit employed the clearly erroneous standard only in reviewing the district court's conclusion on infringement (not claim construction).

Notwithstanding that the standard of review was not properly presented as a question for review as part of the Petition, the Federal Circuit in fact did apply the appropriate standard and were the question to be considered, it would not provide an appropriate basis for granting certiorari.

At best, all Fromson can be seeking here is error correction. The Federal Circuit sitting en banc in *Cybor*, resolved any intra-circuit disagreement over what standard of review should apply in claim construction cases. Fromson is left to complain only that his case, resolved prior to *Cybor*, was decided under an older, "wrong" standard. Pet. at 13-14. This presents no question of law, let alone an intra-circuit split. Here too, Fromson seeks only to have the Court act as a "super" court of appeals, applying the agreed-upon law to the facts of his particular case.

III.

NO INTERVENING DEVELOPMENTS WARRANT THE GRANT OF CERTIORARI, VACATION OF THE OPINION BELOW, AND REMAND FOR FURTHER CONSIDERATION (GVR) SOUGHT BY FROMSON[13]

The power of this Court to issue a GVR order is one that is "exercised sparingly." *Stutson v. United States*, 516 U.S. 163, 173 (1996) (per curiam). The circumstances that warrant such relief are generally either later or unconsidered decisions of this Court, state supreme court decisions, new federal statutes, administrative interpretation of federal statutes, and related intervening events. *See id.* at 166-67 (collecting cases and circumstances). Further, the grant of a GVR ultimately depends on the equities of the case.

Fromson argues that this Court should GVR in light of *Markman I* and *II*, the *Southwall*[14] line of decisions, and *Cybor*. Except for *Cybor*, these decisions were rendered long before *Fromson II*. As for *Markman*, both *Markman I* and *II* were cited and relied upon by the *Fromson II* court. This case warrants no further reconsideration by the Federal Circuit. In *Cybor*, the *Fromson II* decision was *expressly* considered and the court concluded that *Fromson II* is consistent with *Markman*. *See Cybor*, 138 F.3d at 1455 n.3, Pet. App. at 61a n.5. Fromson can point to nothing in the law or the factual record which establishes that there was clear error below or failure to recognize or consider controlling precedent. Under these circumstances, GVR is not warranted.

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13. This section addresses Fromson's Reason VII for granting the writ.

14. *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570 (Fed. Cir. 1995).

IV.

THERE IS NEITHER INTRA-CIRCUIT CONFLICT, NOR ANY PUBLIC POLICY REASONS WARRANTING GRANT OF THE PETITION[15]

In 1996, this Court unanimously affirmed that the question of claim construction is purely an exercise to be undertaken by the judiciary, as a matter of law. Now, two years later, Fromson urges that an intra-circuit split has developed within the Federal Circuit "on the recurring and important issue of claim construction and the standard of appellate review." Pet. at 22. To the extent that such a rift *may* have existed, and a careful review of the relevant cases leaves doubt that it did, the nearly unanimous en banc opinion of the Federal Circuit in *Cybor* lays to rest any such concern. As Senior Circuit Judge Archer, the author of the principal *Cybor* opinion observes:

> After the Supreme Court's decision in *Markman II*, panels of this court have generally followed the review standard of *Markman I*. In some cases, however, a clearly erroneous standard has been applied to findings considered to be factual in nature that are incident to the judge's construction of patent claims. *We ordered that this case be decided in banc to resolve this conflict, and we conclude that the de novo standard of review as stated in Markman I remains good law.*

Cybor, 138 F.3d at 1454-55, Pet. App. at 60a-61a (citations omitted) (emphasis added). Even in his concurrence, Circuit Judge Plager acknowledged that *Cybor*:

> was taken in banc for the sole purpose of laying to rest any residual doubts about how, in claim

15. This section specifically addresses Fromson's Reason VI for Granting the Writ, but is applicable to all of Reasons I-VII.

> construction, the verbalizations surrounding the familiar 'fact-law' dichotomy should be understood. I join the Court's opinions and judgment, eliminating the unnecessary obfuscation that seems to have emerged since our decision in [*Markman I*].

Id. at 1462, App. at 76a (Plager concurring). There is no intra-circuit conflict on the standard of appellate review appropriate to the review of patent claim construction.

To the extent any panels of the court of appeals may have strayed from the standard set down by this Court, the Federal Circuit set its own house in order by reviewing *Cybor en banc.*

No intra-circuit split nor strong public policy reason warrants this Court again reviewing the law concerning the application of extrinsic evidence to the claim construction exercise. *This Court in Markman II directly addressed this issue,* as recognized by the en banc *Cybor* court:

> Further supporting the conclusion that claim construction is a pure issue of law is the Supreme Court's analysis of the role of expert testimony in claim construction. Generally, the Court has recognized the important role played by juries in evaluating the credibility of a witness, a key consideration in determining the appropriate judicial actor to decide an issue. [*See Miller v. Frenton,* 474 U.S. 104, 114 (1985)]. In the context of claim construction, however, the Court reasoned that, while credibility determinations theoretically could play a role in claim construction, the chance of such an occurrence is "doubtful" and that "any credibility determinations will be subsumed within the necessarily sophisticated analysis of the whole document,

> required by the standard construction rule that a term can be defined only in a way that comports with the instrument as a whole." *Markman II*, [517 U.S. at 389].

Cybor, 138 F.3d at 1455-56, App. at 62a-63a. Fromson seeks to create confusion and schism where none exists. In its review of the patent cases which reach it from the district courts, the Federal Circuit applies a uniform, well defined, and well-reasoned standard of review regarding the construction of patent claims, all in principle and application wholly consistent with the precedent of this Court, including most recently, *Markman II*. There is no issue of critical importance for resolution by this Court, and no basis for the grant of a Writ.[16]

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16. As a final matter, there is also no critical issue of public importance in having this Court review, decide and announce the meaning of the term "anodizing" as used in a now expired patent. That question, correctly decided below, has meaning only to the parties to this litigation.

CONCLUSION

For the reasons stated, the Petition for a Writ of Certiorari should be denied.

Respectfully submitted,

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